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| 10/803,390 | 03/18/2004 | Roar Viala | ROAR-00101 | 5520 |

7590
James A. Gavney Jr.
725 Wildwood Lane
Palo Alto, CA 94303

07/18/2007

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| EXAMINER |
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MONIKANG, GEORGE C

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| ART UNIT | PAPER NUMBER |
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2615

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/803,390

Applicant(s)

VIALA, ROAR

Examiner

George C. Monikang

Art Unit

2615

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>See Continuation Sheet</u> . | 6) <input type="checkbox"/> Other: _____ |

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :2/2/2007, 12/1/2004, 6/3/2004, 4/26/2004.

DETAILED ACTION

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 13 & 21 (Application No. 10/803,390, hereinafter referred to as '390) are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 & 15 of copending (Application No. 11/212,510, hereinafter referred to as '510). Although the conflicting claims are not identical, they are not patentably distinct from each other.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

The '390 claims 1, 13 & 21 are broader recitations of the same invention claimed in '510 claims 1 & 15. Therefore, '510 claims 1 & 15 are encompassed by '390 claims 1,

13 & 21. It is critical that patents issuing from these applications be commonly owned to avoid potential licensees from owing license fees to two different parties.

Claim 6 (Application No. 10/803,390, hereinafter referred to as '390) is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 17 of copending (Application No. 11/212,510, hereinafter referred to as '510). Although the conflicting claims are not identical, they are not patentably distinct from each other.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

The '390 claim 6 is a broader recitation of the same invention claimed in '510 claim 17. Therefore, '510 claim 17 is encompassed by '390 claim 6. It is critical that patents issuing from these applications be commonly owned to avoid potential licensees from owing license fees to two different parties.

Claims 5, 6 & 19 (Application No. 10/803,390, hereinafter referred to as '390) are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 7 of copending (Application No. 11/212,510, hereinafter referred to as '510). Although the conflicting claims are not identical, they are not patentably distinct from each other.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

The '390 claims 5, 6 & 19 are broader recitations of the same invention claimed in '510 claim 7. Therefore, '510 claim 7 is encompassed by '390 claims 5, 6 & 19. It is critical that patents issuing from these applications be commonly owned to avoid potential licensees from owing license fees to two different parties.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 4 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The limitation "detachable connector" was not disclosed in the specification. The claim will be analyzed and rejected according to examiner's best knowledge.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 6 recites the limitation "the sealed diaphragm". There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3, 6-8, 10, 12-18 & 20-23 are rejected under 35 U.S.C. 102(e) as being anticipated by Jannard et al, US Patent Pub. 2004/0160572 A1. (This reference is in IDS filed 2/2/2007)

Re Claim 1, Jannard et al discloses a system for underwater entertainment (para 0136), the system comprising: a) media player unit for playing media data and generating audio signals therefrom (abstract); b) an input means for inputting the media data into the media player unit (para 0075); c) a water resistant housing for housing the media player unit (para 0136); and d) an output means for outputting the audio signals (fig. 3a: 16a & 14a).

Re Claim 2, Jannard et al discloses the system of claim 1, further comprising means for coupling the media player unit to a user's head (fig. 3a).

Re Claim 3, Jannard et al discloses the system of claim 1, wherein the output means comprises a water resistant speaker for conducting the audio signals to a portion of a user's head (para 0136).

Re Claim 6, Jannard et al discloses the system of claim 1, further comprising means for plugging the user's ears while the sealed diaphragm is in contact with the bony portion of the user's head (fig. 3a: eyeglass wear is strapped at a bony portion of user's head while the speakers are located at the user's ears).

Re Claim 7, Jannard et al discloses the system of claim 1, wherein the media player is an MP3 player configured to play MPEG-1 Audio Layer-3 compressed format media files (para 0108).

Re Claim 8, Jannard et al discloses the system of claim 1, wherein the input means comprises a memory device for storing the media data (abstract; para 0108).

Re Claim 10, Jannard et al discloses the system of claim 1, wherein the input means comprises an input port for transmitting the media data to the media player unit from a media data source (para 0075).

Re Claim 12, Jannard et al discloses the system of claim 10, wherein the input port comprises a USB connection for coupling to the media data source through a computer (para 0011).

Re Claim 13, Jannard et al discloses a system for playing digital media data, the system comprising an underwater media player comprising: a) a media storage unit for storing the digital media data (abstract); b) a digital processor for reading and converting the digital media data into audio output signals (abstract); and c) means for transmitting the audio output signals to a water resistant audio output unit (fig. 3a: 16a & 14a), wherein a user can listen to the audio output signals while submersed in water

(para 0136) and with the water resistant audio output unit coupled to a portion of the user's head (fig. 3a).

Re Claim 14, Jannard et al discloses the system of claim 13, further comprising a water resistant housing for housing the media storage unit and the digital processor (para 0136), the water resistant housing being configured for coupling to the user's head (fig. 3a).

Re Claim 15, Jannard et al discloses the system of claim 13, further comprising means for transmitting the digital media data to the media storage unit from a media data source (para 0075).

Re Claim 16, Jannard et al discloses the system of claim 15, wherein the means for transmitting the digital media data to the media storage unit from the media data source comprises one or more of a physical connection and a wireless receiver (para 0075).

Re Claim 17, Jannard et al discloses the system of claim 13, wherein the digital processor is configured to decompress the media data stored on the media storage unit in a compressed format (para 0008).

Claim 18 has been analyzed and rejected according to claim 7.

Re Claim 20, Jannard et al discloses the system of claim 19, further comprising ear plugs (fig. 3a: 16a & 14a'; para 0008).

Re Claim 21, Jannard et al discloses a system for playing music while in a water environment, the system comprising: a) an MP3 player and recorder contained within a water resistant housing for playing and recording MP3 files (abstract; para 0108; para

0136); b) one or more water resistant sealed membrane transducers coupled to the MP3 player and recorder for producing audible representations of the MP3 files with the one or more water resistant sealed membrane transducers in contact with a bony portion of a user's head (para 0136; fig. 3a: eyeglass wear is strapped at a bony portion of user's head while the speakers are located at the user's ears); and c) an input port for down-loading MP3 files from a computer (para 0075).

Re Claim 22, Jannard et al discloses the system of claim 21, further comprising means for coupling the MP3 player and recorder to a portion of the user's body (abstract; fig. 3a).

Re Claim 23, Jannard et al discloses the system of claim 22, wherein the means for coupling the MP3 player to the portion of the user's body comprises a strap (para 0081; fig. 3a: 54' & 56').

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jannard et al, US Patent Pub. 2004/0160572 A1 as applied to claim 3 above, in view of Magnusson et al, US Patent Pub. 2002/0176593 A1.

Re Claim 4, Jannard et al discloses the system of claim 3, but fails to disclose wherein the water resistant speaker comprises a detachable connector feature for detachably coupling to an output port on the water resistant housing. However, Magnusson et al does (para 0022).

Taking the combined teachings of Jannard et al and Magnusson et al as a whole, one skilled in the art would have found it obvious to modify the system of Jannard et al with wherein the water resistant speaker comprises a detachable connector feature for detachably coupling to an output port on the water resistant housing as taught in Magnusson et al (para 0022) to protect the speakers against damage.

Claims 5, 9, 11 & 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jannard et al, US Patent Pub. 20040160572 A1.

Re Claim 5, which further recites, "Wherein the water resistant speaker comprises a sealed diaphragm for contacting a bony portion of a user's head." Jannard et al does not explicitly disclose a diaphragm as claimed. Official notice is taken that both the concepts and advantages of providing a diaphragm are well known in the art. It would have been obvious to use a diaphragm since it is commonly used to transmit or produce sound waves.

Re Claim 9, which further recites, "Wherein the memory device comprises a removable memory unit." Jannard et al does not explicitly disclose a removable memory unit as claimed. Official notice is taken that both the concepts and advantages of providing a removable memory unit are well known in the art. It would have been obvious to use a removable memory unit since it is commonly used to transfer data at faster speeds (e.g. memory sticks).

Re Claim 11, which further recites, "Wherein the input port comprises a USB connection for coupling to the media data source through a computer." Jannard et al does not explicitly disclose a USB connection as claimed. Official notice is taken that both the concepts and advantages of providing a USB connection are well known in the art. It would have been obvious to use a USB connection since it is commonly used as a standard connection means with computers.

Claim 19 has been analyzed and rejected according to claims 5 & 6.

Contact

Any inquiry concerning this communication or earlier communications from the examiner should be directed to George C. Monikang whose telephone number is 571-270-1190. The examiner can normally be reached on M-F. alt Fri. Off 7:30am-5:00pm (est).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chin Vivian can be reached on 571-272-7848. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

George Monikang

7/6/2007


XU MEI
PRIMARY EXAMINER

~~PRIMARY EXAMINER
XU MEI~~